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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/427,263	10/26/1999	RICHARD HANS HARVEY	Q56191	2940

7590 06/29/2004

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EXAMINER

ALAM, SHAHID AL

ART UNIT	PAPER NUMBER
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2172

DATE MAILED: 06/29/2004

19

Please find below and/or attached an Office communication concerning this application or proceeding.



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19

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Commissioner for Patents

Shahid Al Alam
Primary Examiner
Art Unit: 2172

Office Action Summary

Application No.

09/427,263

Applicant(s)

HARVEY, RICHARD HANS

Examiner

Shahid Al Alam

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 June 2004.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-60 is/are pending in the application.
4a) Of the above claim(s) 6-11, 13-30, 36-40, 42-55 and 59 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-5, 12, 31-35, 41, 56-58 and 60 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. The request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for Continued Examination under 37 CFR 1.114, the fee set forth in 37 CFR 1.17(e) has been paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 17 June 2004 has been entered. An action on the RCE follows.

Response to Amendment and Arguments

2. The preliminary amendment filed on 17 June 2004 has been considered but is ineffective to overcome the Leung reference.
3. Applicant's arguments filed on 17 June 2004 have been fully considered but they are not persuasive for the following reasons.
4. Applicant's main argument is that Leung does not teach or suggest a method of storing data in a database comprising obtaining both a protocol encoded raw from a data to be stored and a syntax-normalized form of the data, and storing concurrently in at least two tables both the syntax-normalized form and the protocol encoded raw form of the data.

Leung provides a description of each of the claimed elements and each of the descriptions is understandable by one of ordinary skill in the art for the purpose of anticipation, implicit disclosure and/or inherent anticipation.

Schering Corp. v. Geneva Pharmaceuticals Inc., 64 USPQ2d 1032 (DC NJ 2002),

decided August 8, 2002. *The prior art disclosure need not be express in order to anticipate.* Even if a prior art inventor does not recognize a function of his or her process, the process can anticipate if that function was inherent. To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency is not necessarily coterminous with the knowledge of those of ordinary skill in the art. Artisans of ordinary skill may not recognize the inherent characteristics or functioning of the prior art. However, the discovery of a previously unappreciated property of a prior art composition, or of a scientific explanation for the prior art's functioning, does not render the old composition patentably new to the discoverer. Insufficient prior understanding of the inherent properties of a known composition does not defeat a finding of anticipation. Reference: is made to MPEP 2144.01 - Implicit Disclosure "[I]n considering the disclosure of a reference, it is proper to take into account not only specific teachings of the reference but also the inferences which one skilled in the art would reasonably be expected to draw therefrom." In re Preda, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968).

The applicant has pointed to selected sections of the Leung reference wherein a prototype has been referred to, but ignored other relevant teachings.

The applicant asserts that Leung does not teach at least two tables. Contrary to the above assertion, Leung teaches at least two table as claimed. Leung, in Fig. 6, shows a table namely, "ENTRY". In the "ENTRY" table, Leung shows two elements

"Norm-value" and "Raw-value". This reads on the claimed step of "storing concurrently both the syntax-normalized form and protocol-encoded raw form of said data" as recited in claim 1, because the "Norm-value" and "Raw-value" are equated with the "syntax-normalized form" and "protocol-encoded raw form" respectively. See page 739, column 2, First paragraph: The "ENTRY" table holds detailed information about each directory object. See also, page 737, column 1, 2nd paragraph, lines 3 – 9: "The Directory Information Base (DIB) is a logical database composed of directory entries, each of which is a collection of information on one directory object. Each object belongs to one or more object classes." See also page 738, column 1, 2nd d paragraph, column 2, 1st paragraph: "DIBP is an object-oriented database built on top of a commercial relational database management system." Leung therefore teaches directory objects that are mapped to the attributes in a relational database in X.500-compatible system. Since Leung treats the entries in the directory as objects, each object can be mapped to one or more tables. What has been shown in Figure 6, "ENTRY" is an exemplary table wherein both protocol-encoded and syntax-normalized data are concurrently stored for one objects. However such a row/table can be done for any number of objects. Thus Leung teaches multiple tables as required by the claims. See also page 739, First paragraph, where Leung teaches that the structural part of DIBP consists of two objects, the DIT and ENTRY, stored as two relational tables.

Applicant's argument that Leung is a prototype and therefore not enabling is irrelevant because the examiner has pointed to the descriptions provided by Leung. The applicants has not given any reason as to why these descriptions are not adequate, but

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rather points to certain sections of the Leung reference only to find it not teaching the claimed invention.

Applicant's arguments do not comply with 37 CFR 1.111 (c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 – 5, 12, 31 – 35, 41, 56 – 58, and 60 are rejected under 35 U.S.C.

102(b) as being anticipated by the publication, "An Object.-Oriented Approach to Directory Systems," by C.M.R. Leung, IEEE Region 10 Conference on Computer and Communications Systems, September, 1990, Hong Kong, pages 736 – 740, hereinafter, "Leung."

With respect to claim 1, Leung teaches a method of storing data in a database comprising: obtaining both a protocol-encoded raw form of data to be stored and a syntax-normalized form of said data; and storing concurrently in at least two tables both

the syntax-normalized form and protocol-encoded raw form of said data (Page 738, column 2, Figure 6 and Page 739, column 1, First paragraph).

As to claim 2, first obtaining the protocol-encoded form of data; and then generating a syntax-normalized form of data (page 738, col. 2).

As to claim 3, maintaining both the syntax-normalized and protocol-encoded form of data for database searching and data retrieval (page 738, column 2, last paragraph).

As to claim 4, maintaining both the syntax-normalized and protocol-encoded form of data for database searching and data in a table (Figure 6 of page 738, column 2, shows tables).

As to claim 5, correlating the storage location of said protocol-encoded form and said syntax-normalized form in the table (Figure 6 of page 738, column 2, shows tables).

As to claim 12, a method of locating data in a database wherein the data is stored linked to a syntax-normalized form of the data and comprising the step of locating said data by searching on said syntax-normalized form of the data (page 738, column 2, Figure 6).

Claims 31 – 35 are essentially the same as claims 1 – 5 except that they set forth the claimed invention as an apparatus rather than a method and rejected for the same reasons as applied above.

Claim 41 is essentially the same as claim 12 except it sets forth the claimed invention as an apparatus rather than a method and rejected for the same reasons as applied above.

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With respect to claim 56, Leung further teaches an apparatus for transferring data in and out of a database for a directory service system wherein the data is stored in protocol-encoded form and in syntax-normalized form as claimed comprising means for finding data in the database using a syntax-normalized form; and means for transferring data out of the database using a protocol-encoded form (Page 738, column 2, Figure 6 and Page 739, column 1, First paragraph).

Claim 57 is essentially the same as claim 1 except it sets forth the claimed invention as a computer program product rather than a method and rejected for the same reasons as applied above.


As to claims 58 and 60 which further limit the protocol-encoded form as being ASN.1 formats, see Leung, page 736, column 1 and 2, Sections, "Introduction" and "Directory Systems" that detail various directory services standards.

Contact Information

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shahid Al Alam whose telephone number is (703) 305-2358. The examiner can normally be reached on Monday-Thursday 8:00 A.M. - 4:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E Breene can be reached on (703) 305-9790. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Shahid Al Alam
Primary Examiner
Art Unit 2172

25 June 2004